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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,269	08/01/2001	Jean-Louis Valadier	032326-143	5181

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EXAMINER

LEE, DIANE I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,269

Applicant(s)

VALADIER, JEAN-LOUIS

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the Preliminary Amendment filed 01 August 2001. Claims 1-12 have been amended; and no claims have been newly added. Currently, claims 1-12 are pending in this application.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 10 is objected to because of the following informalities:

(a) Re claim 10, line 2: It is vague and indefinite as to what is "it" in the claim. The word "it" should be changed to --authentication session--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-7 and 9-12 are rejected under 35 U.S.C. 102(a) as being anticipated by the admitted prior art by the applicant [referred as APA].

Re claims 1 and 12: APA teaches that a method of controlling the user of a smart card comprising a microprocessor (not specifically shown) that executes cryptography calculations in the card for effecting authentication sessions at the time of the a transaction between the card and a terminal (see page 2, lines 10+), and at least one control counter (a session counter NTX, see page 3, lines 7, and figure 1), comprising:

decrementing or incrementing the control counter by one unit (not specifically shown) at the start of a transaction (i.e., at an initialization phase) comprising at least one authentication session by the card (see page 3, lines 18+);

subsequently incrementing or decrementing by a unit, respectively, the control counter by the unit during the transaction, which clearly teaches the authentication phase has been successfully executed; and

the fact that the authentication is done by the card, the smart card clearly having a structure (i.e., the control counter, microprocessor, and etc.) and capability to executes cryptography calculation.

Re claim 2: wherein the control counter counts up to a blocking value, for example 300 times (see page 3, line 7-page 4, line 27);

Re claim 3: the smart card implementing at least one encrypting key (secret key KDX contained the card) (see page 3, lines 13+);

Re claim 4: wherein the blocking value associated with a counter is a function of the transaction in which an associated key is used (see page 3, lines 23+);

Re claim 5, 7: wherein the decrementation of incrementation unit of a control counter represents the number of cryptographic calculations with an associated key performed up till then and including the one consisting of the authentication session during the transaction (see page 3, lines 7+);

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Re claim 6: wherein the control counter associated with a key is incremented by the unit (not specifically shown) at the initialization phase before each of the cryptographic calculation using the key up to and including the one relating to the authentication session by the card, , (see page 3, lines 18+);

Re claim 9: the fact that APA states that during the transaction mode of the terminal, the terminal is connected to a bank server (see page 1, lines 8+), which clearly teaches that the authentication session by the card is effected at the time of a connection by direct link to a server.

Re claim 10: when the control counter is incremented up to a limit value (e.g., 300 times), the authentication session blocks the use of the associated key (see page 3, lines 7+).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over APA. The teachings of APA have been discussed above.

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The APA teaches the control counter counts up to a blocking value (e.g., 300 times) and the session counter NTX is incremented, which obviously teaches the step of storing the number of incrementation by the unit to control the subsequent incrementing of the control counter. However, APA does not expressly teach the step of incrementing of the control counter via the content of the point counter. It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that the incrementing session obviously includes a pointing counter so as to regulate the incrementing operation to control the authentication session. Accordingly, such modification would have been obvious extension taught by APA.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Geronimi [US 5,296,687], Hoppe [US 5,068,894], and Pailles et al. [US 5,495,098] discloses a method of controlling the use of a smart card having a microprocessor performing cryptography calculation in the card and a control counter;

Le Roux [US 5,191,193] and Iijima [US 5,225,664] discloses the controlling the use of a smart card having an authentication session.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.
March 18, 2003